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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/518,636	03/03/2000	Hideyuki Makitani	35.G2546	5830
5514	7590	10/29/2003	EXAMINER	
FITZPATRICK CELLA HARPER & SCINTO 30 ROCKEFELLER PLAZA NEW YORK, NY 10112			POON, KING Y	
			ART UNIT	PAPER NUMBER
			2624	

DATE MAILED: 10/29/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)	
	09/518,636	MAKITANI, HIDEYUKI	
	Examiner King Y. Poon	Art Unit 2624	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on \_\_\_\_.
- 2a) This action is FINAL.      2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-25 is/are pending in the application.
  - 4a) Of the above claim(s) 3-5,8-14 and 17-25 is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_ is/are allowed.
- 6) Claim(s) 1,2,6,7,15 and 16 is/are rejected.
- 7) Claim(s) \_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 03 March 2000 is/are: a) accepted or b) objected to by the Examiner.
 

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) The proposed drawing correction filed on \_\_\_\_ is: a) approved b) disapproved by the Examiner.
 

If approved, corrected drawings are required in reply to this Office action.
- 12) The oath or declaration is objected to by the Examiner.

#### Priority under 35 U.S.C. §§ 119 and 120

- 13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) All b) Some \* c) None of:
  1. Certified copies of the priority documents have been received.
  2. Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
  - a) The translation of the foreign language provisional application has been received.
- 15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

#### Attachment(s)

- |                                                                                               |                                                                             |
|-----------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                   | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). ____ . |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)          | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____ . | 6) <input type="checkbox"/> Other: ____ .                                   |

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## **DETAILED ACTION**

### ***Election/Restriction***

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:

Group I. Claims 1, 2, 6, 7, 15, 16 are drawn to an image reading apparatus for reading a document, classified in class 359, subclass 17.

Group II. Claims 3-5, 8-10, 17-19 are drawn to image forming apparatus, classified in 358, subclass 1.1.

Group III. Claims 11-14, 20-25 are drawn to an image communication authentication system between two terminals, classified in 709, subclass 201.

2. The inventions are distinct, each from the other because of the following reasons:

Inventions (I, II) and III are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability and (2) that the subcombination has utility by itself or in other combinations. (MPEP 806.05(c)). In the instant case, the combination (communication authentication system) as claimed does not require the particulars of the subcombination (image reading apparatus) and does not require the particulars of the subcombination (image forming apparatus) as claimed for patentability because: the details in the broadest subcombination (image reading apparatus/method) claim 6 recites, for example, an input procedure for inputting the management information, which is not recited in the broadest combination claim 21, and the subcombination (image reading apparatus/method) has separate

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utility such as providing an image to a computer; the details in the broadest subcombination (image forming apparatus/method) claim 8 recites, for example, a determination procedure for determining permission/prohibition of image reading, which is not recited in the broadest combination claim 21, and the subcombination (image forming apparatus/method) has separate utility such as forming an image on a recording medium.

Inventions I and II are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention II has separate utility such as forming an image on a recording medium. See MPEP § 806.05(d).

3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

4. Claims 1, 6, 15 links inventions III. The restriction requirement between the linked inventions is subject to the nonallowance of the linking claims, claims 1, 6, 15. Upon the allowance of the linking claims, the restriction requirement as to the linked inventions shall be withdrawn and any claims depending from or otherwise including all the limitations of allowable linking claims will be entitled to examination in the instant application. Applicants are advised that if any such claims depending from or including all the limitations of the allowable linking claims

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are presented in a continuation or divisional application, the claims of the continuation or divisional application may be subjected to provisional statutory and/or nonstatutory double patenting rejections over the claims of the instant application. Where a restriction requirement is withdrawn, the provisions of 35 U.S.C. 121 are no longer applicable. In re Ziegler, 44 F.2d 1211, 1215, 170 USPQ 129, 131-32 (CCPA 1971). See also MPEP 804.01.

5. During a telephone conversation with Mr. Leonard P. Diana on 10/23/2003 a provisional election was made without traverse to prosecute the invention of group I, claims 1, 2, 6, 7, 15, 16. Affirmation of this election must be made by applicant in responding to this office action. Claims 3-5, 8-14, 17-25 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

*Specification*

6. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

*Claim Rejections - 35 USC § 102*

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

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(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claims 1, 2, 6, 7, 15, 16 are rejected under 35 U.S.C. 102(b) as being anticipated by Otsuka (US 5,579,126).

Regarding claim 1: Otsuka teaches an image reading apparatus (facsimile apparatus 50, fig. 1 in the reception station, column 8, lines 5-10) comprising: selection means (program code, column 4, lines 5-10, that controls the connection to source station, column 8, lines 10-18) for selecting and connecting one of a plurality of image forming apparatuses (source station, column 8, lines 9-15, column 7, line 66); first determination means (the software of the facsimile machine that determining to perform step 401, out of steps 401-409, fig. 7) for determining whether or not input of management information (response, column 9, line 6) relating to a user is to be requested of the user, (response, is relating to a user because it is a request for the systems to perform pre-transmission procedure such that the user can use the systems, column 9, lines 9-14) based on information received (calling signals, column 9, line 7) from the selected image forming apparatus; input means (the transmission program that controls the transmitting of the response 401, fig. 7) for inputting the management information (response) and transmitting the input management information to the selected image forming apparatus, in accordance with a determination of the first determination means; second determination means (the program that performs the pre-transmission procedure, column 9, lines 9-15) for determining information (the information used in pre-transmission procedure) relating to permission/prohibition (inherent properties of pre-transmission procedure; pre-transmission procedure determines when the data is allowed to be

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transmitted) of image reading of an image (receiving the image of document, column 9, lines 15-20, column 7, lines 63-68) of an original transmitted from the selected image forming apparatus, in accordance with the input and transmitted management information and image reading means (the receiving program that controls the reception of the original document images, column 9, lines 15-20, and transmitting of scanned document, column 7, lines 63-65) for reading the image of the original, based on a determination of the second determination means, and for transmitting (the signal of the scanned document, column 7, lines 63-65; after the document is received and printed out, column 9, lines 58-62) an image signal representing the read image to the selected image forming apparatus.

Regarding claim 2: Otsuka teaches wherein the image reading means compresses (column 8, lines 20-26) the image signal and then transmits the compressed image signal.

Regarding claims 6, 7: Claims 6-7 are method claims for the reading apparatus discussed in claims 1-2; please see discussion of claims 1-2.

Regarding claims 15, 16: Otsuka teaches a computer readable memory (ROM, column 4, line 8) storing a program for controlling the reading apparatus/method discussed in claims 1, 2, 67, please see discussion on claims 1, 2.

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***Conclusion***

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

US 6,438,574 (Nagashima) teaches multifunctional apparatus communications.

US 5,157,726 (Merkle et al) teaches multifunctional apparatus communications.

US 6,195,177 (Marechal) teaches multifunctional apparatus communications.

US 5,870,207 (Kamimoto et al) teaches multi functional apparatus communications.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to King Y. Poon whose telephone number is (703) 305-0892

October 26, 2003

*King Yen Poon*